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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/765,985	01/19/2001	Michael A. Sharp	65-1	1204

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EXAMINER	
MYHRE, JAMES W	
ART UNIT	PAPER NUMBER
3688	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/765,985	SHARP, MICHAEL A.	
	Examiner	Art Unit	
	JAMES W. MYHRE	3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11 March 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *14-37* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *14-37* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *3/11/08*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____ .

DETAILED ACTION

Response to Amendment

1. This Office Action is in response to the After-final amendment filed on March 11, 2008. The Amendment canceled Claims 5-13, amended Claim14, and added new Claims 30-37. Thus, the currently pending claims considered below are Claims 14-37.

2. The Declaration filed on March 11, 2008 under 37 CFR 1.131 is sufficient to overcome the Weisberg (6,351,736) reference.

Information Disclosure Statement

3. The Information Disclosure Statement filed on March 11, 2008 has been considered by the Examiner. A annotated copy is attached hereto.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 14-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolfe et al (5,931,901).

Claim 14: Wolfe discloses a system for distributing advertising, comprising a network server with one or more audio files available for download by visitors, wherein the audio files include an embedded audio message from a sponsor (column 2, line 60 – column 3, line 3 and column 6, line 21 – column 7, line 5) and further discloses encrypting the file so that the user "can not separate the music from the advertising copy and/or copy it for their personal use or dissemination, in violation of licensing terms" (column 6, lines 7-12). While Wolfe does not explicitly disclose that the combined file being downloaded is stored on the user device, the disclosure that the user may attempt to disseminate the file at least implies that it has been or could be stored on the user device. By discussing how the security measures can prevent the user from being able to copy and disseminate the files Wolfe is explicitly teaching that without the security procedures a user could copy and disseminate the file. Thus, the system designer is given two options: either allowing the user to copy and disseminate the file or using encryption to prevent the user from doing so. Additionally, Official Notice is taken that it was old and well known at the time of the invention that any incoming data file can be locally stored, either on the receiving device's hard drive or on any one or more types of removable storage devices, e.g. floppy disks, smart cards, tapes, CD-ROMs, DVDs, etc. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Wolfe to store the incoming combined data file. One would have been motivated to store the file in order to facilitate the user ordering the advertised item as discussed in Wolfe (column 6, lines 14-20).

Claims 15 and 16: Wolfe discloses a system as in Claim 14 above, and further discloses determining royalty fees due to the owner of the audio file based on the "play" statistics (column 5, lines 34-37).

Claims 17-19: Wolfe discloses a system as in Claim 14 above, and further discloses the sponsor of the message is someone who has paid the web site operator to embed the message into the audio file (i.e. an advertiser) and who is someone other than the web site operator or the artist/author of the audio file (column 4, lines 7-59).

Claim 20: Wolfe discloses a system as in Claim 14 above, and further discloses the web site is configured to accept uploads of audio files and sponsor messages (column 3, lines 33-46).

Claim 21: Wolfe discloses the system as in Claim 20 above, and further discloses embedding the message into the audio file before it is downloaded to the user device (column 2, line 60 – column 3, line 3).

Claim 22: Wolfe discloses a system as in Claim 14 above and further discloses the multimedia file comprises a musical composition/performance (column 2, lines 18-30 and column 4, lines 18-25).

Claim 23: Wolfe discloses a system as in Claims 8 and 14 above, but does not explicitly disclose using files in wav, MP3, or compressed formats (column 1, lines 24-27 and column 5, lines 37-41). However, Official Notice is taken that these were old and well known standard formats for data files at the time the invention was made. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to format the data file in Wolfe using any of the standard formats known at the time to include wav, MP3, or other compression formats. One would have been motivated to use such compression formats in order to reduce the amount of bandwidth needed to transmit these large audio files.

Claim 24: Wolfe discloses a method comprising:

downloading an audio file with an audible advertisement from a web site to a user's computer (column 2, line 60 – column 3, line 3 and column 6, line 21 – column 7, line 5), but does not explicitly disclose transferring the audio file to an external playing device. Official Notice is taken that it is old and well known within the computer industry that both locally stored files and incoming data stream files may be transferred to removable storage devices, such as CD-ROMs, smart cards, tape, etc. For example, users have been recording radio and television broadcasts onto audio tapes for years. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for the user in Wolfe to save the incoming data stream onto a removable storage medium such as a disc or smart cart that may be played on an external playing device (e.g. PDA, cell phone, etc.). One would have been motivated to

store the combined file onto a removable storage medium in order to allow the user to listen to the audio file at the desired time and location.

Claim 25: Wolfe discloses a method as in Claim 24 above, and further discloses that the audio file and the advertisement are delivered in an inseparable stream (column 3, line 1-3). Thus, the advertisement would inherently play each time the audio file is played.

Claim 26: Wolfe discloses a method as in Claim 25 above, and further discloses that the audio file is a song or single (column 2, lines 18-30 and column 4, lines 18-25).

Claim 27: Wolfe discloses a method as in Claim 24 above, and further discloses the sponsor of the message is someone who has paid the web site operator to embed the message into the audio file (i.e. an advertiser) and who is someone other than the web site operator or the artist/author of the audio file (column 4, lines 7-59).

Claim 28: Wolfe discloses a method as in Claim 27 above, and further discloses that the advertisement is appended to the beginning of the audio file ("leader") prior to being made available for downloading (column 6, lines 32-39).

Claim 29: Wolfe discloses a method as in Claim 24 above, but does not explicitly disclose using files in wav, MP3, or compressed formats (column 1, lines 24-27 and

column 5, lines 37-41). However, Official Notice is taken that these were old and well known standard formats for data files at the time the invention was made. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to format the data file in Wolfe using any of the standard formats known at the time to include wav, MP3, or other compression formats. One would have been motivated to use such compression formats in order to reduce the amount of bandwidth needed to transmit these large audio files.

Claims 30 and 35-37: Wolfe discloses a method comprising:

a. receiving a message file having an audible message (i.e. advertisement) (Figure 1, item 26);

b. receiving licensed multimedia files (i.e. music files)(Figure 1, item 30);

c. appending the message file to the multimedia file to create a combined file (column 2, line 60 — column 3, line3);

d. making the combined file available to users on the Internet (column 2, line 60 – column 3, line 3); and

e. transmitting the combined file to a requesting user for playback of the message with each playback of the multimedia file(column 2, line 60 – column 3, line 3).

While Wolfe does not explicitly disclose that the combined file being downloaded is stored on the user device for later playback, the disclosure that the user may attempt to disseminate the file at least implies that it has been or could be stored on the user device. By discussing how the security measures can prevent the user from being able

to copy and disseminate the files Wolfe is explicitly teaching that without the security procedures a user could copy and disseminate the file. Thus, the system designer is given two options: either allowing the user to copy and disseminate the file or using encryption to prevent the user from doing so. Additionally, Official Notice is taken that it was old and well known at the time of the invention that any incoming data file can be locally stored, either on the receiving device's hard drive or on any one or more types of removable storage devices, e.g. floppy disks, smart cards, tapes, CD-ROMs, DVDs, etc. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Wolfe to store the incoming combined data file. One would have been motivated to store the file in order to facilitate the user ordering the advertised item as discussed in Wolfe (column 6, lines 14-20).

Claim 31: Wolfe discloses a method as in Claim 30 above, and further discloses determining royalty fees due to the owner of the audio file based on the "play" statistics (column 5, lines 34-37).

Claims 32 and 33: Wolfe discloses a method as in Claim 30 above, and further discloses the message provider (advertiser) providing advertising preferences along with the message delineating the targeting criteria. While it is not explicitly disclosed that the advertising preferences would include the music genre or specific music files desired by the advertiser, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include such preferences. One would have

been motivated to include the identification of the music file or the genre of the music as an advertising preference in order to prevent the advertisement from being presented with music that contradicts the advertisement (e.g. playing an advertisement from General Motors with the song "Mustang Sally", since a Mustang is a Ford Motor Company product) or that goes against the values of the advertiser (e.g. US Army recruitment advertisement with an anti-war song).

Claim 34: Wolfe discloses a method as in Claim 30 above, and further discloses that the combined file may be transmitted to a second different user (i.e. inherently, the combined file may be transmitted to many other requesting users as long as they match the targeting profile). Wolfe also discusses encrypting the combined file so that the first user cannot “copy it for their personal use and dissemination” (column 6, lines 7-12). This teaches that if the file is not encrypted, then a user would be able to copy and disseminate the combined file (to a second different user).

Response to Arguments

6. Applicant's arguments with respect to claims 14-37 have been considered but are moot in view of the new ground(s) of rejection.

The Applicant argues that Wolfe does not imply storing the incoming combined file because the reference teaches using security measures to prevent copying and dissemination of the file. However, by discussing how the security measures can prevent the user from being able to copy and disseminate the files it is explicitly

teaching that without the security procedures a user could copy and disseminate the file. Thus, the system designer is given two options: either allowing the user to copy and disseminate the file or using encryption to prevent the user from doing so.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES W. MYHRE whose telephone number is (571)272-6722. The examiner can normally be reached on Monday through Thursday 6:00-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JWM
March 24, 2008

/James W Myhre/
Primary Examiner, Art Unit 3688